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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DARNO, PATRICK A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/688,602	Applicant(s) ISHIGURO ET AL.	
	Examiner PATRICK A. DARNO	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,17 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11292007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. No new claims were added. Claims 1, 3, 17, and 20 are amended. Claims 2, 4-16, and 18-19 are cancelled. Claims 1, 3, 17, and 20 are pending in this office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Examiner Automated Search Tool (EAST) Text Search Training Manual (hereinafter "EAST") and further in view of U.S. Patent Application Publication Number 2005/0119995 issued to Eugene M. Lee (hereinafter "Lee").

Claim 1:

EAST discloses a data searching apparatus that searches a database of patent document data files for a desired patent document data file (*EAST: page 6 and page 9 and page 11 and page 29*), based on a search condition set by a user (*EAST: see at least page 29 and page 55; Note that the BRS form window is used by the user to enter a search condition.*), the data searching apparatus comprising:

a receiving unit configured to receive, from the user, a search query that is a logical formula including an AND search query and an OR search query (*EAST: see at least page 29 and page 55 and page 65; The BRS Form window is the receiving unit.*);

a search query displaying unit configured to display the search query received by the receiving unit on a first window that is opened in a region of a screen (*EAST: page 29 and page 65; The tree view window is the search query displaying unit.*);

a searching unit configured to search the database for one or more patent document data files that satisfy the search query received by the receiving unit (*EAST: page 6; The EAST BRS/Search and Database Server is the searching unit.*);

a data-file-list displaying unit configured to display a list of the one or more patent document data files that are search results by the searching unit on a second window that is opened in a region different from the region of the screen in which the first window is opened, such that the first window and the second window are simultaneously displayed on the screen (*EAST: page 29 and page 65; The Details Grid is the data-file-list displaying unit. Note that the Details Grid displays the search results for the particular search string selected in the search query displaying unit (tree view window). Further note that at least the first window (search query displaying unit (tree view)) and second window (data-file-list displaying unit (details grid)) are displayed on the screen simultaneously.*);

a file selection unit configured to cause the user to refer to the search query displayed on the first window and the list of the one or more patent document data files displayed on the second window that are displayed on the screen (*EAST: page 29 and page 65; The Details Grid is the data-file-list displaying unit. Note that the Details Grid displays the search results for the particular search string selected in the search query displaying unit (tree view window). Further note that at least the first window (search query displaying unit (tree view)) and second window (data-file-list displaying unit (details grid)) are displayed on the screen simultaneously.*), and cause the user to operate the second window so as to select one of

the one or more patent document data files (*EAST: page 29 and page 99 and page 101 and page 102; Note that any of the patents in the Details Grid (second window) can be selected for viewing, sorting, filtering, etc.*); and

the first window, the second window, and a third window are simultaneously displayed on the screen (*EAST: page 29; Note that at least a first window, a second window, and a third window are displayed on the screen.*).

It appears that EAST does not explicitly disclose:

wherein each patent document data file including a plurality of search keys for providing clues to know contents of the patent document data files, the search keys being categorized in a plurality of fields including an IPC symbol, an F-term, and a keyword,

an extracting unit configured to extract a plurality of frequently-used search keys for each of the fields, from the patent document data file that is a selection result by the selection unit, the searching unit includes:

a search-key-list displaying unit configured to display a list of the frequently-used search keys extracted for each of the plurality of fields by the extracting unit on a third window that is opened in a region different from the regions of the screen in which the first window and the second window are opened;

a key-selection unit configured to cause the user to refer to the search query displayed on the first window, the list of the one or more patent document data files displayed on the second window, and the list of the frequently-used search keys displayed on the third window that are displayed on the screen, and cause the user to operate the third window so as to select one of the frequently used search keys; and

a retry search unit operable to add the selected search key selected in the key-selection unit, as an element of the OR search query for each of the fields, to the search query, create a new search query, transmit the new search query to the search query displaying unit to cause the search query displaying unit to display the new search query on the first window, and retry the search for a desired patent document data file that satisfies the new search query, wherein the data searching apparatus repeats retrying the search unit until the desired patent document data is found.

However, Lee discloses:

wherein each patent document data file including a plurality of search keys for providing clues to know contents of the patent document data files, the search keys being categorized in a plurality of fields including an IPC symbol, an F-term, and a keyword (*Lee: paragraphs [0037] – paragraph [0039]*),

an extracting unit configured to extract a plurality of frequently-used search keys for each of the fields, from the patent document data file that is a selection result by the selection unit (*Lee: paragraph [0038] and paragraph [0039] and paragraphs [0029] – [0031]; “Once the source grouping is retrieved...for use by the IP Thesaurus module...a review of the select intellectual property information in the source grouping is made...to ascertain the different elements...**found in the source grouping...and generate a list thereof.**” “..to produce useful information such as the frequency of occurrence of the different elements...” Note that the word-frequency list of words generated from words “found in the source in the source grouping” of documents. It is clear that the words in the word-frequency list are extracted from the patent document data.),*

the searching unit includes:

a search-key-list displaying unit configured to display a list of the frequently-used search keys extracted for each of the plurality of fields by the extracting unit on a third window that is opened in a region different from the regions of the screen in which the first window and the second window are opened (*Lee: paragraph [0039]*);

a key-selection unit configured to cause the user to refer to the search query displayed on the first window, the list of the one or more patent document data files displayed on the second window, and the list of the frequently-used search keys displayed on the third window that are displayed on the screen, and cause the user to operate the third window so as to select one of the frequently used search keys (*Lee: paragraphs [0020] and [0042]*); and

a retry search unit operable to add the selected search key selected in the key-selection unit, as an element of the OR search query for each of the fields, to the search query, create a new search query, transmit the new search query to the search query displaying unit to cause the search query displaying unit to display the new search query on the first window, and retry the search for a desired patent document data file that satisfies the new search query (*Lee: paragraphs [0019] - [0020], [0033], and [0042] - [0043]*), wherein

the data searching apparatus repeats retrying the search unit until the desired patent document data is found (*Lee: paragraphs [0042] - [0043] and Fig. 4, elements 606, 607, 609*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify EAST with the teachings of Lee noted above. The skilled artisan would have been motivated to improve EAST per the above in order to provide a user with an aid in learning a new technology (*Lee: see at least the abstract and paragraph [0005]*). Furthermore, the skilled artisan would have been motivated to improve EAST with the teachings of Lee in order to

increase the robustness of the intellectual property data search (*Lee: see at least the abstract and paragraph [0042], lines 11-14*).

Claim 3:

The combination of EAST and Lee discloses all the elements of claim 1, as noted above, and EAST further discloses wherein,

the file-selection receiving unit receives, from the user, selection of a plurality of patent document data files one after another from the list displayed by the data-file-list displaying unit (*EAST: page 29 and page 65; Each of the patent document data files can be selected from the search results list presented in the Details Grid.*), and

an output instruction to output each of the selected patent document data files (*EAST: page 29 and page 99 and page 101 and page 102; Note that any of the patents in the Details Grid (second window) can be selected for viewing, sorting, filtering, etc.*),

It appears that EAST fails to disclose wherein the a key extraction instruction is received to extract search keys from each of the selected patent document data files,

the selective extracting unit extracts search keys from each of the selected patent document data files when the file-selection receiving unit receives the key extraction instruction,

the searching unit, every time when the file-selection receiving unit receives selection of one or a predetermined number of patent document data files, reads the selected patent document data files and stores therein the read patent document data files, and

the data searching apparatus further comprises:

a resulting outputting unit operable to output the patent document data files stored in the searching unit when the file-selection receiving unit receives the output instruction.

However, Lee discloses wherein the a key extraction instruction is received to extract search keys from each of the selected patent document data files (*Lee: paragraph [0038] and paragraph [0039] and paragraphs [0029] – [0031]; “Once the source grouping is retrieved...for use by the IP Thesaurus module...a review of the select intellectual property information in the source grouping is made...to ascertain the different elements...**found in the source grouping...and generate a list thereof.**” “..to produce useful information such as the frequency of occurrence of the different elements...” Note that the word-frequency list of words generated from words “found in the source in the source grouping” of documents. It is clear that the words in the word-frequency list are extracted from the patent document data),*

the selective extracting unit extracts search keys from each of the selected patent document data files when the file-selection receiving unit receives the key extraction instruction (*Lee: paragraph [0038] and paragraph [0039] and paragraphs [0029] – [0031]),*

the searching unit, every time when the file-selection receiving unit receives selection of one or a predetermined number of patent document data files, reads the selected patent document data files and stores therein the read patent document data files (*Lee: paragraphs [0031] and [0038]; Note that the “search results may be output to the user in any known fashion, including on user interface...**and stored in a user workspace...**”), and*

the data searching apparatus further comprises:

a resulting outputting unit operable to output the patent document data files stored in the searching unit when the file-selection receiving unit receives the output instruction (*Lee: paragraphs [0031] and [0038]; Note, “The search results may be output...”*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify EAST with the teachings of Lee noted above. The skilled artisan would

have been motivated to improve EAST per the above in order to provide a user with an aid in learning a new technology (*Lee: see at least the abstract and paragraph [0005]*). Furthermore, the skilled artisan would have been motivated to improve EAST with the teachings of Lee in order to increase the robustness of the intellectual property data search (*Lee: see at least the abstract and paragraph [0042], lines 11-14*).

Claim 20:

The combination of EAST and Lee discloses all the elements of claim 1, as noted above, and Lee further discloses wherein the search-key-list displaying unit simultaneously displays the search keys in a plurality of categories adjacent a display of the search condition to enable a user to paste the displayed search keys so as to modify the search condition for a further search query (*Lee: paragraph [0042]*).

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable EAST in view of Lee and further in view of U.S. Patent Application Publication Number 2003/0074671 issued to Tomokazu Murakami et al. (hereinafter “Murakami”).

Claim 17:

The combination of EAST and Lee discloses all the elements of claim 1, as noted above, but it appears that the previously mentioned combination does not explicitly disclose wherein the search key display unit displays the hit ratio.

However, Murakami discloses wherein the search key display unit displays the hit ratio (*Murakami: paragraph [0055], lines 31-35 and Fig. 9, 908; The display and use of a hit ratio or some other form of document relevancy indicator is extremely well known in the art.*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Murakami noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that results could be returned, ordered, and displayed based upon a hit ratio (*Murakami: paragraph [0055], lines 31-35*).

Response to Arguments

Examiner Notes:

- The Examiner considered a rejection of claim 1 under 35 U.S.C. 101 since it briefly appeared that claim 1 could possibly be directed to solely software. However, after further examination, claim 1 includes carrying out a search and displaying windows "in a region of a screen." Since the claim requires that certain objects are displayed on a screen (monitor, lcd display...), it appears that the Apparatus of claim 1 includes a combination of hardware and software, and is therefore statutory under 35 U.S.C. 101.
- It is believed that the Applicant's arguments received 01/15/2008 are moot in light of the new grounds of rejection presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PATRICK A. DARNO whose telephone number is (571)272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wilson Lee/
Primary Examiner, Art Unit 2163

/Patrick A. Darno/
Examiner
Art Unit 2163
04/28/2008

PAD